

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANTS: James D. Kelly and Michael L. Regal
APPLICATION NO.: 10/669,119 (REI OF 5,996,036)
FILING DATE: September 22, 2003
TITLE: BUS TRANSACTION REORDERING IN A COMPUTER SYSTEM HAVING UNORDERED SLAVES
EXAMINER: Glenn Allen Auve
GROUP ART UNIT: 2111
ATTY. DKT. NO.: 18602-08098 (P2080R1C1)

CERTIFICATE OF ELECTRONIC (EFS-WEB) TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with 37 C.F.R. § 1.8(a)(i)(C) from the Pacific Time Zone of the United States on the local date shown below.

Dated: January 12, 2009 By: /Sabra-Anne R. Truesdale/
Sabra-Anne R. Truesdale, Reg. No. 55,687

REPLY BRIEF TO SUPPLEMENTAL EXAMINER'S ANSWER

This Reply Brief is filed in accordance with 37 C.F.R. § 41.41 and § 41.43, in response to the Supplemental Examiner's Answer, mailed on November 12, 2008.

Argument

In the course of this appeal, the dispute between the appellants and the examiner has focused on whether the present continuation reissue application is required to address a “specific error” that was identified in the original reissue declaration filed within the two-year deadline. The appellants have already refuted that as a basis for rejecting the application, in both the

Appeal Brief and the previous Reply Brief, and those arguments will not be repeated here. But the examiner did raise a new issue in the Supplemental Examiner’s Answer, which is addressed in this Reply. In particular, the examiner now argues that the continuation reissue application violates § 251 because it was “applied for” more than two years after the issue date of the original patent. (Supplemental Examiner’s Answer, p. 4.) The new argument is equally unavailing.

The reissue statute provides that: “No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.” 35 U.S.C. § 251 (emphasis added). Quoting *In re Doll*, 419 F.2d 925, 164 U.S.P.Q. 218 (CCPA 1970), the examiner correctly points out that that “the language ‘applied for’ [in § 251] refers to the filing of an application.” But then the examiner concludes that “the broadened claims were not presented in an application ‘applied for’ within two years of the issue date of the original patent.” (Supplemental Examiner’s Answer, p. 5.) This is a clear error, as it misunderstands fundamentally what a continuation application is.

A continuation application that satisfies the requirements of § 120 is entitled to the benefit of the filing date of the previously filed application to which it claims priority. 35 U.S.C. § 120. Specifically, the statute provides that a continuation application “shall have the same effect . . . as though filed on the date of the prior application.” *Id.* The examiner has never argued that the continuation reissue application at issue in this appeal fails to satisfy the requirements of § 120. Therefore, there is no dispute that this application is entitled to the benefit of the filing date of the original reissue application and thus shall have “the same effect” as that application. Since the original application was filed within the two-year period, the

present continuation reissue application must be treated as having been filed, or “applied for,” within that two-year period.

In addition to the plain and unambiguous reading of the Patent Act, this conclusion is supported by prior cases as well as the examiner’s manual. For example, the Federal Circuit has explained that: “The statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met.” *In re Graff*, 111 F.3d 874, 876 (Fed. Cir. 1997). Moreover, the MPEP specifically addresses this issue: “Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing (continuation or divisional) reissue application after the two year period.” MPEP § 1412.03.

Because the parent reissue application was applied for within the two year period, the present continuation reissue application was also applied for within the two year period.

Lastly, the examiner concludes the Supplemental Examiner’s Answer by yet again erroneously comparing the facts in this appeal to the situation in *Ex parte Luu*, Appeal No. 96-1181, Application No. 08/188,764 (BPAI 1997); therefore, this will be addressed once more to clear the record. In *Luu*, the applicant filed a new reissue application one day before the first reissue application issued, and more than two years after the original patent grant. The Board held that the second reissue application was improper because (1) it was a new broadening reissue application filed more than two years from the original patent grant, and (2) it was an attempt to reissue another application before that application had actually issued in the first place. That situation is clearly inapposite because neither of those facts is true in this appeal.

Moreover, the Board in that case suggested that the applicants' mistake was to characterize the second reissue as a reissue of the first reissue, rather than a continuation reissue application: "Appellants are not seeking a second reissue of the original patent, but rather, are seeking a first reissue of the first reissue patent." *Luu*, at 15. In other words, the Board was criticizing the applicants in *Luu* for not seeking what the applicants have sought in the present continuation reissue application — "a second reissue of the original patent."

For the foregoing reasons, appellants believe that the examiner's rejection of claims 18-19 was erroneous and requires reversal by the Board.

Respectfully submitted,
James D. Kelly and Michael L. Regal

Dated: January 12, 2009

By: /Sabra-Anne R. Truesdale/

Sabra-Anne R. Truesdale, Reg. No. 55,687
Attorney for Applicants
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7187
Fax: (650) 938-5200